In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 288.

FRANK H. STELLAR & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION AND HOWARD C. STRAUSS,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Bayard D. Watts,
Morris Hirsch,
Counsel for Petitioner.

George H. Dearborn,
Of Counsel.

THE BYRON S. ADAMS PRINTING CO., WASHINGTON, D. C.—SEPT. 1941

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION AND HOWARD G. STRAUSS,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Petitioner prays that this Court grant rehearing of its Order of October 22d, 1951, denying the Petition for Writ of Certiorari, and that a Writ issue to review the Judgment of the Court of Appeals for the Second Circuit in the above cause, as prayed for in the Petition filed August 20, 1951.

REASON FOR GRANTING REHEARING.

A substantial ground available to petitioner but not previously presented is that

PETITIONER WAS DENIED DUE PROCESS OF LAW BY THE COURT BELOW.

The practical effect of the judgment of the Court below is to deprive the petitioner of property without affording petitioner an opportunity to be heard in its defense.

The patents here are very valuable as is shown by a few record facts. They made it possible to manufacture

and sell prophylactics at the same price for 19 years (R. 50-51) while the costs of the machines were increasing six-fold (R. 49-50) and labor costs were tripling (R. 48-9). Licensees paid royalties at the rate of ten cents (10¢) per gross on goods produced by these inventions (R. 40). During the years of the Second World War, the licensees produced over four million (4,000,000) gross of prophylactics annually (R. 33). The Armed Services of the United States purchased tremendous quantities of these goods for the prevention of disease and these goods were also used for many other purposes (R. 108). Recognizing their value in preventing transmission of disease, another branch of the United States government, through enforcement of the Federal Food Drug & Cosmetics Act (21 U. S. C. 301, *et seq.*) prevents the sale of these goods which are defective as is fully brought out in the companion case of *Youngs Rubber Corp. v. Allied Latex Corp.*, 188 F. (2d) 945, in which a petition for rehearing is being filed concurrently herewith.

As has been pointed out (Pet. pp. 7, 10, 12-15), the Court below held the patents invalid because petitioner had not proved that certain prior patents were "widely known in the art" (R. 831). Although this was a new rule which the Court had created *after argument of the case*, the Court denied petitioner's motion for remand to the District Court to afford an opportunity for presentation of proof of the character required by the new rule. Thus the Court below destroyed valuable property rights while refusing petitioner an opportunity to protect them.

Indeed the Court below has since implicitly admitted not only the novelty of this rule but also the injustice of denying petitioner's motion to remand. For within three months thereafter, the Court cited the new rule in another case and then, *of its own motion*, remanded the case to

afford the patentee an opportunity to adduce evidence required by the new rule. We have reference to *Landis Machine Co. et al. v. Parker-Kalon Corp. et al.*, 190 F. (2d) 543, 547, wherein the Court said:

> "* * * we are not satisfied that the claims in suit are valid; indeed on this record we think them invalid. *Yet it is fair to send back the cause for a new trial on the issue of validity where it can be presented in some such way as we have indicated.* The plaintiffs may be able to show that Heim and Hanson were well known to the art for a substantial part of the seven years after 1927; they may also be able to show that such a combination would always have been welcomed; and in support of that conclusion to show that the art has adopted it very widely to the exclusion of existing methods. In such a setting our doubts arising from our a priori decision that the combination was not patentable, may disappear. We will not now prejudge the decision of the district court by any present intimations; but we do hold that on the record before us the judgment must be reversed and the cause remanded for a new trial on the issue of validity." (Emphasis is ours.)

Under circumstances similar to those existing here, this Court reversed the Supreme Court of Missouri on the ground that such circumstances constituted denial of the due process of law guaranteed by the Fifth and Fourteenth Amendments to the Constitution. In *Brinkerhoff-Faris Trust and Savings Co. v. Hill*, 281 U. S. 673, this Court said:

> "The plaintiff seasonably filed a petition for a rehearing in which it * * * asserted * * * that * * * in refusing relief because of the newly found powers of the commission, the court transgressed the due process clause of the 14th Amendment. * * * The petition was denied without opinion. This court

> granted certiorari, 280 U. S. 550, ante, 608, 50 S. Ct. Rep. 162. We are of opinion that the judgment of the Supreme Court of Missouri must be reversed, because it has denied to the plaintiff due process of law—using that term in its primary sense of an opportunity to be heard and to defend its substantive right." (pp. 677, 678.)

In that case, as here, the denial of due process of law was accomplished by the judiciary. Nevertheless this Court held as follows:

> "The federal guaranty of due process extends to state action through its judicial, as well as through its legislative, executive or administrative branch of Government." (p. 680.)

This Court went on to point out that its concern was "solely with the question whether the plaintiff has been accorded due process in the primary sense,—whether it has had an opportunity to present its case and be heard in its support" (p. 681). The Court below in the present case had no more right, than did the Supreme Court of Missouri in the above quoted case, to "deprive a person of all existing remedies for the enforcement of a right," unless he was afforded "some real opportunity to protect it" (p. 682).

CONCLUSION.

For the foregoing reasons, petitioner respectfully submits that this petition for rehearing should be granted and that a writ of certiorari should issue to the Court of Appeals for the Second Circuit.

In focusing this petition for rehearing on the denial of procedural due process, petitioner in no sense abandons its earlier contentions. However, since the foregoing new rule was the primary, if not sole, basis for the decision of the

Court below, petitioner's property rights would be adequately protected by the rejection of that rule by this Court. In that event it would be appropriate for this Court to reverse the Court below and reinstate the judgment of the District Court without remanding the case for a new trial on the issue of validity.

Respectfully submitted,

BLYTHE D. WATTS,
MORRIS HIRSCH,
Attorneys for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Certificate of Counsel.

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 33 of the Rules of this Court.

BLYTHE D. WATTS,
Counsel for Petitioner.

Dated: Cleveland, Ohio,
Nov. 5, 1951.

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONSE TO PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Invoking the Fifth and Fourteenth Amendments to the Constitution, petitioner claims that it has been deprived of property without due process of law. The property of which petitioner claims to have been unlawfully deprived consists of the two patents in suit, which petitioner still insists were held invalid by the Court of Appeals. But as pointed out on page 1 of our brief in opposition to the petition for certiorari, the first patent in suit, the one that expired eight years ago this month, was *not* held invalid. The Court of Appeals found that respondent was following the prior art and so did not infringe. It is difficult to find any deprivation of property here. The second patent in suit was held invalid for lack of invention over two prior patents. If the petitioner here was deprived of his patent property without due process of law, then every patentee whose patent is held invalid is similarly deprived, and R. S. 4920 is unconstitutional. Yet no court has ever so held.

Petitioner bases its whole petition for rehearing on the Court of Appeals' statement (R. 831) that an inventor

> "* * * when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, * * * must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

Petitioner characterizes this as a new rule and complains that the Court's denial of its motion for remand to the district court "to afford an opportunity for presentation of proof of the character required by the new rule" destroyed valuable property rights. Petitioner complains that in a later case, *Landis Mach. Co. et al.* v. *Parker-Kalon Corp. et al.,* 190 F. 2d 543, the Court of Appeals did remand, and should have done so here. In the *Landis Mach Co.,* case, however, the Court of Appeals had expressed some doubt as to the validity of the claims in suit and felt that further evidence might resolve that doubt. In the instant case, on the contrary, the Court entertained no doubt on the score of invalidity and so properly refused to remand. The matter was one clearly within its discretion.

In *Brinkerhoff-Faris Trust & Savings Co.* v. *Hill,* 281 U. S. 673, a tax case, the complaint was dismissed by the highest state court solely on the ground that the plaintiff had an adequate legal remedy before a state tax commission, and that the plaintiff was not entitled to equitable relief, because of laches in failing to proceed before the commission. The highest state court had previously held that the commission had no power to decide the tax question. The result was that plaintiff was thrown out of court without a hearing. That is not the situation here.

Rule 33, 2. of this Court confines the grounds on which a petition for rehearing may be filed "to intervening cir-

cumstances of substantial or controlling effect, or to other substantial grounds available to petitioner although not previously presented". Petitioner alleges the latter. But the ground now asserted was previously asserted on pages 12 through 15 of the petition for certiorari. Petitioner is advancing the same old argument decked out in a new garb.

THE PETITION FOR REHEARING IS DEVOID OF MERIT AND SHOULD BE DENIED.

Respectfully,

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New York 17, New York,

Attorneys for Respondent.

November 12, 1951.

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IN THE

Supreme Court of the United States

October Term, 1951.
No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari and Supporting Brief.

J. CALVIN BROWN,
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Parker & Company, Law Printers, Los Angeles. Phone MA. 6-9171.

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October Term, 1951.
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Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Comes now J. Calvin Brown, of the Bar of the United States Supreme Court, and respectfully petitions for leave to file a brief *amicus curiae* on the grounds:

(1) that the decision of the United States Court of Appeals for the Second Circuit in the above-entitled case formulates new rules for invalidating patents, which rules are contrary to those applied by this Court and by other Courts of Appeals and which vitally affect the patent system, and

(2) that these newly formulated rules are matters of great public interest and importance to inventors, patent owners and all members of the public who make, use or sell patented articles.

Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients.

The brief for which leave to file is hereby requested accompanies this Petition.

This Petition is presented in good faith and is filed solely in what is believed to be the public interest. Petitioner does not represent any of the parties hereto nor has he any interest in the specific subject matter of the suit.

J. CALVIN BROWN,
Petitioner, Amicus Curiae.

IN THE

Supreme Court of the United States

October Term, 1951.
No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Brief Amicus Curiae on Petition for Writ of Certiorari.

The new rules formulated by the Court of Appeals in the present case appear to strike at the very vitals of the entire patent system. If allowed to stand and serve as precedent they will nullify the patent statutes by making it impossible to sustain a patent.

The Court of Appeals sets up the following unprecedented tests:

(1) Only if the teaching of the patent in suit displays a greater skill than that of an *inventor* (rather than that of a mechanic skilled in the art) can the patent be valid.

(2) A prior, non-anticipating patent may invalidate a patent for lack of invention, unless the plaintiff proves that the prior patent had been generally or widely known in the art.

(1) The present rule for distinguishing invention from mechanical skill was recently restated by this Court as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art.'" (Citing many cases.)
>
> *Sinclair & Carroll Co. v. Interchemical Corporation,* 325 U. S. 327, 330.

The decision of the Court of Appeals in the instant case (188 F. 2d 940), has replaced the "mechanic skilled in the art" of that rule by *an inventor,* so that the rule as so modified requires a patent to show more ingenuity than the work of an inventor. The Court of Appeals held as follows 188 F. 2d 940 at page 944:

> "Nevertheless, had *an inventor,** bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal resulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed. * * * We cannot agree that, if *an inventor* wished to supply the market with such articles and had the Dutch disclosure before him, this step demanded that degree of exceptional endowment which—especially in recent years—is necessary to support a patent."

It is clear that no patent can be valid if its subject matter must display more ingenuity than the work of *an inventor.*

---

*Emphasis supplied.

It is submitted that the prevailing rule in this Court should continue to be the rule and that the modification of that rule by the Court of Appeals should be overruled.

(2) The Court of Appeals held as follows at page 944:

> "Yet when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, he must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

Other courts of coordinate jurisdiction have held to the contrary that everyone is chargeable with knowledge of the prior patented art, from the date of its grant.

E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. 2d 63 (C. A. 7);

In re Coey & Peterson, 90 U. S. P. Q. 216, 219 (C. C. P. A.).

The rule that an inventor is chargeable with knowledge of the prior art and the general public is not so chargeable could lead to the anomalous situation in which an inventor could at the same time be chargeable, and not chargeable, with knowledge of the same prior art. Assume that an inventor-patentee brings suit for infringement of his patent, that counterclaim is filed for infringement of defendant's patent, and that both parties plead the same prior art. Under the present rule, the plaintiff-inventor would be presumed to have knowledge of all the prior art pleaded against his patent, but under the newly formulated rule he would not be presumed to have had knowledge of any of the same art pleaded by himself.

The Court of Appeals held that the patents in suit were invalidated, each by a different prior patent, because the record did not prove that those prior patents were "generally" or "widely known in the art." The Court said at page 944:

> "As in the case of Hadfield's patent, we should have to be satisfied that the Dutch machine had been widely known in the art;".

Even if the public generally is not chargeable with the same knowledge as is the inventor, there appears to be no good reason why a prior patent, particularly a paper patent, should be promoted to the status of an invalidating patent on the basis of whether or not it was generally or widely known in the art. *The invalidating effect of a prior patent has heretofore depended on its disclosure but under the new rule it would depend on how many people knew about it.*

The new rules set up by the decision in the present case constitute matters of grave concern to the people of this country in connection with the protection of patent rights for inventions provided for by the Constitution and the statutes. These new rules would, if permitted to become the law, presently nullify the patent statutes within the jurisdiction of the Court of Appeals for the Second Circuit and eventually throughout the remainder of the country.

For these reasons, it is respectfully urged that the Petition for Writ of Certiorari be granted.

J. CALVIN BROWN,
Petitioner, Amicus Curiae.

September 20, 1951.

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONDENT'S OBJECTION TO THE FILING OF A BRIEF AS AMICUS CURIAE BY J. CALVIN BROWN.

Mr. J. Calvin Brown of Los Angeles, California, has filed a petition for leave to file a brief as *amicus curiae* in support of the petition for a writ of certiorari herein, and appends to his petition the brief he would like to file. Respondent's consent was not asked but would have been refused in any case for the following reasons:

Rule 27, 9 (c) of this Court provides that a motion for leave to file a brief as *amicus curiae* when consent has been refused

> "shall concisely state the nature of the applicant's interest."

Complying, Mr. Brown writes:

> "Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients",

thus seeking to give the impression that he is the accredited spokesman for the Society and its membership. It is clear, however, from a careful scrutiny of the petition that he has no mandate from the A. S. M. E., and could have none from "the engineering profession generally and their clients". He speaks for no one but himself. Why this gentleman, despite his overweening sense of duty, should be better qualified to instruct the Court than the able lawyers who represent the petitioner, does not appear.

Rule 27, 9 (c) also provides that a motion to file an *amicus* brief without consent shall

> "set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties".

Mr. Brown's motion (designated a petition) makes no attempt to meet this requirement. The reason is not far to seek. Both points made by Mr. Brown in his proposed brief were adequately presented by the parties and the Court needs no further enlightenment from Mr. Brown.

(1) The Court of Appeals' alleged substitution of an inventor for a mechanic skilled in the art in the standard test of invention.

An argument on this point was presented on pages 18 and 19 of the petition for certiorari and answered on pages 12 and 13 of respondent's brief in opposition.

(2) The holding of the Court of Appeals that the art is not presumed to know of any particular prior patent.

An argument traversing this holding was presented on pages 12-15 of the petition for certiorari and answered on pages 11 and 12 of respondent's brief in opposition.

THE PETITION FOR LEAVE TO FILE A BRIEF AS AMICUS CURIAE SHOULD BE DENIED.

Respectfully,

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September 28, 1951.